



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,746	03/24/2004	John Armstrong	EFIM0376	5865
31408 7590 12/07/2007 LAW OFFICE OF JAMES TROSINO 92 NATOMA STREET, SUITE 211 SAN FRANCISCO, CA 94105				
EXAMINER				
RUBIN, BLAKE J				
ART UNIT		PAPER NUMBER		
4152				
MAIL DATE		DELIVERY MODE		
12/07/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,746

Applicant(s)

ARMSTRONG ET AL.

Examiner

Rubin Blake

Art Unit

4152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 24, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/24/2004, 06/20/2005, 07/05/2005, 09/13/2005, and 10/16/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to communications filed March 24, 2004.
2. Claims 1- 24 are pending in this application.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "16" and "20" have both been used to designate a directory server (page 8, line 27).
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "22" and "24" have both been used to designate a second network (page 18, lines 3, 13, 18, & 20; page 23, lines 19 & 21; Figures 7 & 12).
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figures 7, 10, & 12's characters "16", "18", & "28". In Figures 7, 10, & 12, characters "18" & "28" are not described in the specification in relation to the objects displayed in the figure. In Figures 7, 10, & 12, the Directory Server is described by character "16", whereby it has already been established that the Directory Server is represented by character "20".
6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 4152

8. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

9. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29-42 of copending Application No. 10/808,910.

11. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is claiming the method performed by the system described in the copending application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Instant Application	10/808,910
1. A method for use with a first network device coupled to a first network, the first network coupled to a second network, the first network device comprising information identifying the first network device on the first network, the	A system comprising: first and second network devices coupled to a first network, the first network coupled to a second network, the first network device comprising first information identifying the first network device on the first

method comprising: receiving an identification message from the first network device, the identification message comprising the identifying information of the first network device; parsing the identification message to extract the identifying information of the first network device; and searching a directory table to identify a second network device coupled to the first network, the second network device comprising information identifying the second device on the first network.	network, the second computer device comprising second information identifying the second network device on the first network; a directory server coupled to the second network, the directory server adapted to register the first and second identification information, and adapted to process requests for identification information about registered network devices.
2. The method of claim 1, wherein the first network device comprises one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera.	30. The system of claim 29, wherein the first and second network devices each comprise one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera.
3. The method of claim 1, wherein the first network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer.	31. The system of claim 29, wherein the first network device comprises a computer and the second network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer.
4. The method of claim 1, wherein the first network device comprises an Internet protocol telephone.	32. The system of claim 29, wherein the first network device comprises a computer and the second network device comprises an Internet protocol telephone.
5. The method of claim 1, wherein the first network device comprises a network connection for coupling to the first network.	33. The system of claim 29, wherein the first and second network devices each comprise a network connection for coupling to the first network.
6. The method of claim 1, wherein the first network comprises a local area network.	34. The system of claim 29, wherein the first network comprises a local area network.
7. The method of claim 1, wherein the first network comprises a plurality of interconnected networks.	35. The system of claim 29, wherein the first network comprises a plurality of interconnected networks.
8. The method of claim 1, wherein the second	36. The system of claim 29, wherein the

network comprises any of a wide area network, global network, public network, or the Internet.	second network comprises any of a wide area network, global network, public network, or the Internet.
9. The method of claim 1, wherein the first network comprises a firewall, and the first network device is located within the firewall.	37. The system of claim 29, wherein the first network comprises a firewall, and the first and second network devices are located within the firewall.
10. The method of claim 1, wherein the identifying information of the first network device comprises an address.	40. The system of claim 29, wherein the first and second identifying information each comprises an address.
11. The method of claim 1, wherein the identifying information of the first network device comprises an address of the first network device on the first network.	41. The system of claim 29, wherein the first identifying information comprises an address of the first network device on the first network and the second identifying information comprises an address of the second network device on the first network.
12. The method of claim 1, wherein the identifying information of the first network device comprises an address of the first network on the second network.	42. The system of claim 29, wherein the first and second identifying information comprises an address of the first network on the second network.
13. A method for use with first and second network devices coupled to a first network, the first network coupled to a second network, the first network device comprising information identifying the first network device on the first network, the second network device comprising information identifying the second network device on the first network, the method comprising: receiving a first identification message from the first network device, the first identification message comprising the identifying information of the first network device; parsing the first identification message to extract the identifying information of the first network device; registering the first network device in a directory table according to the identifying information of the first network device;	29. A system comprising: first and second network devices coupled to a first network, the first network coupled to a second network, the first network device comprising first information identifying the first network device on the first network, the second computer device comprising second information identifying the second network device on the first network; a directory server coupled to the second network, the directory server adapted to register the first and second identification information, and adapted to process requests for identification information about registered network devices.

receiving a second identification message from the second network device, the second identification message comprising the identifying information of the second network device; parsing the second identification message to extract the identifying information of the second network device; and searching the directory table to identify the first network device based on the identifying information of the second network device.	
14. The method of claim 13, wherein the first and second network devices each comprise one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera.	30. The system of claim 29, wherein the first and second network devices each comprise one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera.
15. The method of claim 13, wherein the first network device comprises a computer and the second network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer.	31. The system of claim 29, wherein the first network device comprises a computer and the second network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer.
16. The method of claim 13, wherein the first network device comprises a computer and the second network device comprises an Internet protocol telephone.	32. The system of claim 29, wherein the first network device comprises a computer and the second network device comprises an Internet protocol telephone.
17. The method of claim 13, wherein the first and second network devices each comprise a network connection for coupling to the first network.	33. The system of claim 29, wherein the first and second network devices each comprise a network connection for coupling to the first network.
18. The method of claim 13, wherein the first network comprises a local area network.	34. The system of claim 29, wherein the first network comprises a local area network.
19. The method of claim 13, wherein the first network comprises a plurality of interconnected networks.	35. The system of claim 29, wherein the first network comprises a plurality of interconnected networks.
20. The method of claim 13, wherein the second network comprises any of a wide area network, global network, public network, or	36. The system of claim 29, wherein the second network comprises any of a wide area network, global network, public network, or

the Internet.	the Internet.
21. The method of claim 13, wherein the first network comprises a firewall, and the first and second network devices are located within the firewall.	37. The system of claim 29, wherein the first network comprises a firewall, and the first and second network devices are located within the firewall.
22. The system of claim 13, wherein the identifying information of the first and second network devices each comprises an address.	40. The system of claim 29, wherein the first and second identifying information each comprises an address.
23. The system of claim 13, wherein the identifying information of the first network device comprises an address of the first network device on the first network and the identifying information of the second network device comprises an address of the second network device on the first network.	41. The system of claim 29, wherein the first identifying information comprises an address of the first network device on the first network and the second identifying information comprises an address of the second network device on the first network.
24. The system of claim 13, wherein the identifying information of the first and second network devices each comprises an address of the first network on the second network.	42. The system of claim 29, wherein the first and second identifying information comprises an address of the first network on the second network.

Table 1

Claim Rejections - 35 USC § 101

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

13. **Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

14. With respect to claims 1 & 13, methods are recited, however it appears the methods fail to provide any apparent utility as stated. Neither method results in a

tangible result that would be understood to be anything other than, "receiving", "parsing", and "searching" in their most abstract forms, and it appears that such abstractions would produce neither a useful, tangible, or concrete result.

15. Claims 2-12, and 14-24, fail to resolve the deficiencies of claims 1, and 13, since they only describe further the "first network device", "first network", "second network device", and "second network", which fail to substantiate the method as performing anything other than a search, and thus renders all claims as a software method.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

17. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Teo et al (U.S. Patent No. 7,293,077), hereinafter Teo.

18. With respect to claim 1, Teo discloses a method for use with a first network device coupled to a first network, the first network coupled to a second network (column 3, lines 12-18), the first network device comprising information identifying the first network device on the first network (column 1, lines 55-67); the method comprising:

receiving an identification message from the first network device, the identification message comprising the identifying information of the first network device (column 1, lines 55-67); parsing the identification message to extract the identifying information of the first network device (column 2, lines 1-7); and searching a directory table to identify a second network device coupled to the first network, the second network device comprising information identifying the second device on the first network (column 2, lines 42-51, whereby the "routing table" cited identifies a table, "for each...network interface indicates the location associated," which is analogous to the "directory table" claimed; column 7, lines 3-12; column 1, lines 50-57, whereby the cited "plurality of networked objects" identifies a "first network device" and a "second network device").

19. With respect to claim 2, Teo discloses the method of claim 1, wherein the first network device comprises one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera (column 16, lines 41-46).

20. With respect to claim 3, Teo discloses the method of claim 1, wherein the first network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer (column 16, lines 35-46).

21. With respect to claim 4, Teo discloses the method of claim 1, wherein the first network device comprises an Internet protocol telephone (column 4, line 6; column 13, lines 24-25).

22. With respect to claim 5, Teo discloses the method of claim 1, wherein the first network device comprises a network connection for coupling to the first network (column 5, lines 15-18; Figure 1).

23. With respect to claim 6, Teo discloses the method of claim 1, wherein the first network comprises a local area network (column 2, lines 52-59, whereby it is inherently known in the art that a private network is an implemented of a local area network; column 6, lines 20-24).

24. With respect to claim 7, Teo discloses the method of claim 1, wherein the first network comprises a plurality of interconnected networks (column 2, lines 29-33).

25. With respect to claim 8, Teo discloses the method of claim 1, wherein the second network comprises any of a wide area network, global network, public network, or the Internet (column 2, lines 21-24).

26. With respect to claim 9, Teo discloses the method of claim 1, wherein the first network comprises a firewall, and the first network device is located within the firewall (column 15, lines 35-42).

27. With respect to claim 10, Teo discloses the method of claim 1, wherein the identifying information of the first network device comprises an address (column 2, lines 1-7).

28. With respect to claim 11, Teo discloses the method of claim 1, wherein the identifying information of the first network device comprises an address of the first network device on the first network (column 6, lines 25-35).

29. With respect to claim 12, Teo discloses the method of claim 1, wherein the identifying information of the first network device comprises an address of the first network on the second network (column 11, lines 10-20).

30. With respect to claim 13, Teo discloses a method for use with first and second network devices coupled to a first network, the first network coupled to a second network (column 3, lines 12-18), the first network device comprising information identifying the first network device on the first network, the second network device comprising information identifying the second network device on the first network (column 1, lines 55-67); the method comprising: receiving a first identification message

from the first network device, the first identification message comprising the identifying information of the first network device (column 1, lines 55-67); parsing the first identification message to extract the identifying information of the first network device (column 2, lines 1-7); registering the first network device in a directory table according to the identifying information of the first network device (column 7, lines 3-12); receiving a second identification message from the second network device, the second identification message comprising the identifying information of the second network device (column 1, lines 55-61); parsing the second identification message to extract the identifying information of the second network device (column 2, lines 1-7); and searching the directory table to identify the first network device based on the identifying information of the second network device (column 2, lines 42-51, whereby the "routing table" cited identifies a table, "for each...network interface indicates the location associated," which is analogous to the "directory table" claimed; column 7, lines 3-12; column 1, lines 50-57, whereby the cited "plurality of networked objects" identifies a "first network device" and a "second network device").

31. With respect to claim 14, Teo discloses the method of claim 13, wherein the first and second network devices each comprise one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera (column 16, lines 41-46).

32. With respect to claim 15, Teo discloses the method of claim 13, wherein the first network device comprises a computer and the second network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer (column 16, lines 35-46).

33. With respect to claim 16, Teo discloses the method of claim 13, wherein the first network device comprises a computer and the second network device comprises an Internet protocol telephone (column 4, line 6; column 13, lines 24-25).

34. With respect to claim 17, Teo discloses the method of claim 13, wherein the first and second network devices each comprise a network connection for coupling to the first network (column 5, lines 15-18; Figure 1).

35. With respect to claim 18, Teo discloses the method of claim 13, wherein the first network comprises a local area network (column 2, lines 52-59, whereby it is inherently known in the art that a private network is an implemented of a local area network; column 6, lines 20-24).

36. With respect to claim 19, Teo discloses the method of claim 13, wherein the first network comprises a plurality of interconnected networks (column 2, lines 29-33).

37. With respect to claim 20, Teo discloses the method of claim 13, wherein the second network comprises any of a wide area network, global network, public network, or the Internet (column 2, lines 21-24).

38. With respect to claim 21, Teo discloses the method of claim 13, wherein the first network comprises a firewall, and the first and second network devices are located within the firewall (column 15, lines 35-42).

39. With respect to claim 22, Teo discloses the system of claim 13, wherein the identifying information of the first and second network devices each comprises an address (column 11, lines 10-20).

40. With respect to claim 23, Teo discloses the system of claim 13, wherein the identifying information of the first network device comprises an address of the first network device on the first network and the identifying information of the second network device comprises an address of the second network device on the first network (column 2, lines 42-51; column 11, lines 10-20).

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Yach et al Pub No. 2002/0128036

b. Keeney et al Patent No. 7,095,518

Art Unit: 4152

- c. Spinks et al Pub No. 2001/0029534
- d. Schaefer Patent No. 6,640,253
- e. Hall et al Pub. No. 2002/013355

42. With respect to claim 24, Teo discloses the system of claim 13, wherein the identifying information of the first and second network devices each comprises an address of the first network on the second network (column 11, lines 10-20).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rubin Blake whose telephone number is (571) 270-3802. The examiner can normally be reached on M-R: 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 4152

BJR

11/27/2007

/Nabil El-Hady/

Supervisory Patent Examiner, Art Unit 4152